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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,449	07/16/2002	Pedro P. Giralt	10682.3801	5790

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT PAPER NUMBER

3679

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,449

Applicant(s)

GIRALT, PEDRO P.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters U.S. Patent 4014520.

Claim 1. Walters discloses (figs.1-3) an improved pedestrian and bicyclist safety railing comprising: a rigid top aluminum bar (14) having a longitudinal, recessed channel (portion of 14 receiving 40) protruding outwardly relative to the center of the bar, the bar channel having a predetermined cross-sectional configuration that includes a pair of tabs (24, 24a) forming upper and lower channel portions (above and below 24a) in the bar channel; a second bottom bar (18) substantially identical to the first bar ; a plurality of elongated, rigid pickets (20) having a substantially rectangular cross section, with the width of one dimension of the rectangular cross section (cross sectional shape of 20) being sized for a snug fit into lower bar channel portions (portions of 18 receiving 20); a plurality of spacer plugs (portions of 40 between 58) having a cross-sectional configuration complementary to and fitting inside the cross-section of the bar channel including a pair of recessed portions (portions of 42 receiving 24a) for receiving the tabs for holding and interlocking the spacer plug within the bar channel, the spacer plugs being sized in length to provide a desired distance apart between the pickets when in spaced engagement between adjacent pickets; and means (10, 10a) for joining the first bar and the second bar in a

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parallel configuration with one another, the plurality of pickets connected between the first bar and the second bar in a common plane, and spaced apart by a plurality of spacer plugs.

Claim 4. Walters discloses (col.2, ll.5-10) the guard railing being constructed of aluminum. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, *i.e.* the functional limitation "to eliminate the welding joints between the pickets and the top and bottom support bars in the guard railing", is given only limited patentable weight since it does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

Claim 5. Walters discloses the safety railing being **suitable for mounting** (but not necessarily mounted) on an inclined surface, the spacer plugs having end faces angled (at 90 degrees) substantially equal to an inclined angle (90 degrees) of the safety railing relative to the longitudinal axis of the spacer plugs for snug engagement with each picket to separate adjacent pickets.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters U.S.

Patent 4014520 in view of Grimm U.S. Patent 4421302.

Claim 2. Walters discloses the spacer plugs (40) each being positioned between a pair of adjacent pickets (20) and mounted within the top bar, an end face (faces of 40 contacting 20) of each spacer plug being substantially perpendicular to the longitudinal axis of each spacer plug for engaging in contact with the side wall of a picket for holding the picket in position. Walters does not disclose the spacer plugs being positioned in the bottom bar. Grimm teaches (figs.4 and 7) spacer plugs (54) being positioned in both a top bar (24) and bottom bar (34) which appears to better support pickets (44). It has generally been recognized that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to duplicate the spacer plugs of Walters such that the railing of Walters has spacer plugs positioned in both the top bar and bottom bar, as taught by Grim, for the purpose of increasing picket support.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters U.S.

Patent 4014520 in view of Ballerstein U.S. Patent 5062732.

Claim 3. Walters discloses a first rigid post (10) and a second rigid post (10a) connected to the top bar and the bottom bar; and means (90b) for anchoring the first post and the second post to a concrete anchor (92) connected to the first post and the second post. Walters does not disclose a welding. Ballerstein teaches (col.1, ll40-45 and col.4, ll.9-14) that it is well known in the art to connect rails to posts by welding and then grinding the weld line for the purpose of

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presenting a stronger and smoother finished joint. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to connect the rails and posts of Walters by welding for the purpose of increasing strength and appearance of the rail to post joints.

Response to Arguments

Applicant's arguments filed on 2/13/2004 with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that the Walters top bar 14 is completely different than the bottom bar 18 in structure. This is not persuasive since the claims do not recite that the top and bottom bars should be exactly identical. Rather, claim 1 requires "a second bottom bar substantially identical the first bar." The word "substantially" is taken by the examiner to mean "being largely but not wholly that which is specified" in accordance with Merriam-Webster's Collegiate Dictionary Tenth Edition. Therefore, Walters bottom bar (18) is substantially identical to the top bar (14) in that it is shaped, arranged and supported in largely the same manner. If the applicant intends for the limitation "substantially" to be meaningless such that it has no effect on the scope of the claims then the limitation "substantially" should be omitted.

The applicant argues that the pickets in Walters require special slots 88 as shown in fig.2 that fit into apertures 58 and engage additional tabs in bar 46. This is not persuasive since the claims do not recite any negative limitation specifically forbidding "special slots". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues that the Walters device shown in figure 2 requires a two dimensional configuration for proper fit. This is not persuasive, as the claims do not specifically state "wherein two dimensional configurations are not used for proper fit". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues that there is no teaching in Walters to mount the railing assembly such that the pickets are angled to compensate for an inclined surface with the pickets remaining vertical and the cross bars being angled. This is not persuasive since the limitation "pickets are angled, etc." is not recited in the claims. Rather, claim 5 recites the functional limitation "said safety railing being suitable for mounting on an inclined surface". The Walters railing is fully capable of being mounted on an inclined surface thereby meeting this functional limitation to the claim. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed (*i.e.* a functional limitation) is given only limited patentable weight since it does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

The applicant argues that the cover locking plate 40 shown in Walters Figure 2 does not engage the pickets with the end face of each spacer plug. This is not persuasive as this is not the exact claim language. Rather, in accordance with claim 2, Walters discloses the spacer plugs (40) each being positioned between a pair of adjacent pickets (20) and mounted within the top bar, an end face (faces of 40 contacting 20) of each spacer plug being substantially perpendicular

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to the longitudinal axis of each spacer plug for engaging in contact with the side wall of a picket for holding the picket in position.

The applicant argues that Grimm is completely different from Walter and the applicant's invention. This is not persuasive. It has been held that a prior art reference must only either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Grimm, Walter and the applicant's invention all deal with handrail assemblies.

In response to applicant's argument that Grimm and Ballerstein cannot be bodily incorporated with Walter, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The applicant argues that there is no motivation to combine Ballerstein with Grimm. This is not persuasive. Motivation to combine comes from Ballerstein (col.1, ll40-45 and col.4, ll.9-14), which states that it is well known in the art to connect rails to posts by welding and then grinding the weld line for the purpose [motivation] of presenting a stronger and smoother finished joint.

Conclusion

This application contains claim 6 and 7 drawn to an invention nonelected with traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701. The examiner can normally be reached on 8:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


VLM
April 1, 2004


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600